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10/674,013	09/29/2003	Mark Bernard Hettish	2003P08064US	2383
7590 03/23/2006			EXAMINER	
Siemens Corporation Attn: Elsa Keller, Legal Administrator Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830			PADMANABHAN, KAVITA	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/674,013	Applicant(s) HETTISH ET AL.	
	Examiner Kavita Padmanabhan	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/29/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-23 are pending.
2. Claims 1-23 are rejected.

Information Disclosure Statement

3. The following items on the information disclosure statement filed 9/29/03 have not been considered as to their merits because the document numbers do not match the listed applicant name: Cite No. I and K.

Specification

4. The abstract of the disclosure is objected to because it contains only 17 words and does not sufficiently describe the disclosure. It is suggested that the abstract be modified to include between 50-150 words. Correction is required. See MPEP § 608.01(b).
5. The disclosure is objected to because of the following informalities:

It is suggested that the phrase "that describes work or non-work state that that the identity is in" at page 3, lines 16-17 be changed to --that describes a work or non-work state that the identity is in--.

Appropriate correction is required. The citations above are not meant to be exhaustive, and are provided as examples. The applicant is advised to correct other similar errors as required throughout the specification.

Claim Objections

6. **Claims 19 and 21** are objected to because of the following informalities:

The acronym "SIP" recited in each claim should be spelled out the first time it is recited in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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8. **Claims 1-6 and 10-23** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

In the instant case, **claims 1-6 and 10-13** recite a method but the method claimed does not produce a useful, concrete and tangible result.

For example, **claim 1** results in maintaining information. This is merely an abstract idea and does not conclude in an actual result. **Claims 2-6 and 10-13** are similarly nonstatutory. Claims 7-9 appear to overcome the deficiencies of the claims from which they depend.

Claims 14-21 recite a system, but the system claimed does not appear to contain components that define the physical structure of the system.

For example, claim 14 recites an application and components, but it appears that these could consist purely of software, which is not statutory. Furthermore, there is no useful, concrete and tangible result from the claim and, as a result, claim 14 is nonstatutory for the same reasons given for claim 1 as explained above. **Claims 15-21** are similarly nonstatutory.

Claim 22 recites an article of manufacture comprising a computer readable medium having instruction which, when executed, cause a processor to perform a method that is substantially the same as the method recited in claim 1, and is similarly nonstatutory.

Claim 23 recites an apparatus comprising a processor, a communication, port, and a storage device storing instructions that perform a method that is substantially the same as the method recited in claim 1. This is equivalent to reciting a computer-implemented method as it is merely form over substance. As a result, claim 23 is nonstatutory for the same reasons given for claim 1 as explained above.

The examiner will apply prior art to these claims as best understood, with the assumption that applicant will amend to overcome the stated 101 rejections.

Claim Rejections - 35 USC § 102

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9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1-11, 13-18, and 21-23** are rejected under 35 U.S.C. 102(e) as being anticipated by **Yoakum et al.** (US 6,658,095, hereinafter "Yoakum").

In regards to **claim 1**, **Yoakum** teaches a method, comprising:

- configuring a first device as an associated device in a system (**Yoakum; col. 4, lines 26-49; Fig. 1, reference character 16B**);
- receiving information regarding a second device from a device management component, said second device being registered with said system (**Yoakum; col. 9, line 46 – col. 10, line 10 – SIP endpoints are considered registered with the system**); and
- maintaining information regarding said first device and said second device (**Yoakum; col. 4, lines 35-67**).

In regards to **claim 2**, **Yoakum** teaches the method of claim 1, wherein said configuring a first device as an associated device in a system includes receiving a call

from an application to configure said first device as an associated device (**Yoakum; col. 4, lines 35-49**).

In regards to **claim 3**, **Yoakum** teaches the method of claim 1, wherein said receiving information regarding a second device from a device management component includes receiving device context information regarding said second device from said device management component (**Yoakum; col. 9, lines 46 – 51**).

In regards to **claim 4**, **Yoakum** teaches the method of claim 1, wherein maintaining information regarding said first device and said second device includes maintaining device context information for said first device and device context information for said second device (**Yoakum; col. 4, lines 35-67; col. 9, lines 46-51**).

In regards to **claim 5**, **Yoakum** teaches the method of claim 1, further comprising:

- receiving a call from an application to configure said first device (**Yoakum; col. 4, lines 35-49**).

In regards to **claim 6**, **Yoakum** teaches the method of claim 1, further comprising:

- receiving a call from an application to set a device context for said first device (**Yoakum; col. 4, lines 35-49**).

In regards to **claim 7**, **Yoakum** teaches the method of claim 6, further comprising:

- providing device context information for said first device to said application
(Yoakum; col. 4, lines 35-67).

In regards to **claim 8**, Yoakum teaches the method of claim 1, further comprising:

- providing device context information for said first device and said second device to an application (Yoakum; col. 4, lines 26-67; col. 9, lines 46-51).

In regards to **claim 9**, Yoakum teaches the method of claim 1, further comprising:

- providing device context information for said first device to said device management component (Yoakum; col. 4, lines 26-67; col. 9, lines 46-51 – device management component is interpreted to be software associated with second device that sends/receives context/state information for the second device – so, if devices are exchanging information, the information relating to the first device is being sent to the second device).

In regards to **claim 10**, Yoakum teaches the method of claim 1, further comprising:

- receiving a query for device context information for said first device (Yoakum; col. 4, lines 26-67 – a request is interpreted to be a query).

In regards to **claim 11**, Yoakum teaches the method of claim 1, further comprising:

- receiving a query for device context information for said first device and said second device (**Yoakum; col. 4, lines 26-67; col. 9, lines 46-51 – a request is interpreted to be a query**).

In regards to **claim 13**, **Yoakum** teaches the method of claim 1, wherein said device management component includes a presence and availability service (**Yoakum; col. 3, lines 40-42; col. 10, lines 54-65**).

In regards to **claim 14**, **Yoakum** teaches a system, comprising:

- an application (**Yoakum; col. 4, lines 35-49**);
- a device management component, said device management component adapted to communicate with a first registered device (**Yoakum; col. 9, line 46 – col. 10, line 10 – SIP endpoints are considered registered with the system**);
- a context management component, said context management component adapted to communicate with a first associated device (**Yoakum; col. 4, lines 26-49; Fig. 1, reference character 16B**), with said application regarding said first associated device and said first registered device (**Yoakum; col. 4, lines 35-67; col. 9, line 46 – col. 10, line 16**), and with said device management component regarding said first registered device (**Yoakum; col. 9, lines 46-51 – device management component is interpreted to be software associated with registered device that sends/receives context/state information for the device**).

In regards to **claim 15**, **Yoakum** teaches the system of claim 14, wherein said application is adapted to send a call to said context management component to configure said first associated device (**Yoakum; col. 4, lines 35-49**).

In regards to **claim 16**, **Yoakum** teaches the system of claim 14, wherein said context management component is adapted to provide device context information for said first associated device to said application (**Yoakum; col. 4, lines 35-67**).

In regards to **claim 17**, **Yoakum** teaches the system of claim 14, wherein said context management component is adapted to send device presence information for said first associated device to said device management component (**Yoakum; col. 3, lines 40-42; col. 4, lines 35-67**).

In regards to **claim 18**, **Yoakum** teaches the system of claim 14, wherein said device management component includes a presence and availability service (**Yoakum; col. 3, lines 40-42; col. 10, lines 54-65**).

In regards to **claim 21**, **Yoakum** teaches the system of claim 14, wherein said application, said context management component and said device management component operate in a SIP environment and said first registered device is registered in said SIP environment (**Yoakum; col. 9, line 46 – col. 10, line 16**).

Claims 22 and 23 are each rejected with the same rationale given for claim 1.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. **Claims 12 and 19-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yoakum** in view of **"SIP (Session Initiation Protocol) in Enterprise-Class IP**

Telephony Networks”, White Paper, Communication without boundaries, 2002, Avaya Inc. (hereinafter “Avaya”), cited by applicant.

In regards to **claim 12**, **Yoakum** teaches the method of claim 1, wherein the first device could be any of a variety of devices, including a cellular phone, etc. (**Yoakum; col. 4, lines 26-34; Fig. 1, reference character 16B**). **Yoakum** does not expressly teach that the first device is not registered with said system.

Avaya teaches, certain devices associated with a user being SIP-enabled and certain devices not being SIP-enabled (**Avaya; p2, right column, paragraph 3, lines 7-9; p3, left column, paragraph 2, lines 2-3; p6, left column, paragraph 1, lines 1-5; p6, right column, paragraph 2, lines 5-6**), which is interpreted as not being registered in the SIP system.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of **Yoakum** with non-registered devices as well, as taught by **Avaya**, thereby allowing the system to address a larger universe of devices and provide services to both SIP and non-SIP endpoints (**Avaya; p2, right column, paragraph 3, lines 7-9; p6, right column, paragraph 2, lines 5-6**).

In regards to **claims 19 and 20**, **Yoakum** teaches the system of claim 14, wherein said system operates in a SIP environment, and said first registered device is registered in said SIP environment (**Yoakum; col. 9, line 46 – col. 10, line 16**).

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Yoakum does not expressly teach that said first associated device is not registered in said SIP environment.

Avaya teaches, certain devices associated with a user being SIP-enabled and certain devices not being SIP-enabled (**Avaya; p2, right column, paragraph 3, lines 7-9; p3, left column, paragraph 2, lines 2-3; p6, left column, paragraph 1, lines 1-5; p6, right column, paragraph 2, lines 5-6**), which is interpreted as not being registered in the SIP system. Avaya also teaches using gateways and other mechanisms of reaching devices that are not on the SIP network system (**Avaya; p2, right column, paragraph 3, lines 7-9; p3, left column, paragraph 2, lines 2-3; p6, left column, paragraph 1, lines 1-5; p6, right column, paragraph 2, lines 5-6**), and such gateways are obviously necessitated because the SIP-devices are not directly aware of the “non-registered” devices.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Yoakum with non-registered devices as well, as taught by Avaya, thereby allowing the system to address a larger universe of devices and provide services to both SIP and non-SIP endpoints (**Avaya; p2, right column, paragraph 3, lines 7-9; p6, right column, paragraph 2, lines 5-6**).

Conclusion

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kavita Padmanabhan** whose telephone number is **571-272-8352**. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kavita Padmanabhan
Assistant Examiner
AU 2161

KP

March 14, 2006



UYEN LE
PRIMARY EXAMINER